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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91163702
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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DA VINCI DENTAL STUDIOS, INC., Opposer, v. CONTESSA DA VINCI s.r.l., Applicant.	Opposition No. 91163702 Application Serial No: 75/796,383 Mark: ALEXANDRA DA VINCI Published: July 13, 2004

OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO DISMISS

Opposer, Da Vinci Dental Studios, Inc. ("Opposer"), a corporation organized and existing under the laws of the State of California, by and through its attorneys Holland & Knight LLP, hereby submit this Opposition to Applicant's Motion to Dismiss for Failure to State a Claim Upon Which Relief Can Be Granted (the "Motion".)

I. INTRODUCTION

Daniel Materdomini is the president and founder of da Vinci Dental Studios, Inc.. ("Opponent.") He has been recognized as one of the leading ceramists in the country. Daniel Materdomini founded da Vinci Dental Studios in the early 1970's, and through it pioneered "porcelain veneers," which it began marketing in 1983 to dental practices across the country. Because of its continuing success, da Vinci

Dental Studios has been featured on network television programs, including the infamous "The Swan" makeover program. Trademark Registration No. 2,061,195 was issued on May 13, 1997 for DA VINCI DENTAL STUDIOS (the "DA VINCI Mark.") to Daniel Materdomini. In 2001, Daniel Materdomini assigned his entire interest in the Mark to Opposer da Vinci Dental Studios, Inc. Opposer avers that the DA VINCI Mark has developed significant goodwill in interstate commerce, and that the DA VINCI Mark is well-known and famous as a distinctive indicator of the origin of Opposer's goods and services.

Applicant Contessa da Vinci s.r.l. ("Applicant"), is a limited liability company organized and existing under the laws of Italy. Applicant admits has applied for the mark ALEXANDRA DA VINCI in International Class 003 as an intent-to-use application (the "Application") and bases its priority claim on its foreign registrations. (Answer, ¶5.) Applicant admits that its goods and services include personal appearance products, which it describes as follows:

> After shave lotions, antiperspirants, bath salts, not for medical use, beauty masks, cakes of toilet soaps, cleansing milk for toilet purposes, cosmetic creams, dentifrices, deodorant soap, deodorants for personal use, essential oils for personal use, eyebrow pencils, hair spray, hair lotions, hair colorants, sachets for perfuming linen, lipsticks, lotions for cosmetic purposes, make-up, make-up powder, mascara, perfumes, oils for cosmetic purposes, oils for toilet purposes, rouge, scented water, shampoos, shaving soaps, toilet soap, sun tanning preparations, talcum powder, tissues impregnated with cosmetic lotions, nail varnish, nail polish, varnish removing preparations

(collectively "Applicant's Goods"). (Answer, ¶5.) Applicant further admits that it has not marketed its products in the United States prior to the Application filing date of September 10, 1999. (Answer, ¶6.)

In its Motion, Applicant concludes that Opposer does not own the DA VINCI Mark, and therefore does not have standing to pursue an opposition to its Application. This, and other assertions of the Applicant in its Answer and Motion, misstate or misconstrue both the facts and the law, as Opposer will demonstrate herein. Opposer owns all right and title to the DA VINCI Mark, and has alleged facts in its Notice of Opposition that demonstrate a direct commercial interest in the DA VINCI Mark that would be harmed if the Application is granted. Thus, Opposer has standing to oppose the Application.

Furthermore, Opposer has alleged that likelihood of confusion with and possible dilution of the DA VINCI Mark are grounds to deny the registration. Thus, Opposer has properly alleged facts that would establish grounds for opposing the Application. LANHAM ACT §2(d), 43(c). Allegations of standing and grounds to oppose the Application are all that is required to defeat a Motion to Dismiss the Opposition for Failure to State a Claim. Order of Sons of Italy in America v. Profumi Fratelli Nostra AG, 36 U.S.P.Q.2d 1221, 1222 (T.T.A.B. 1995.) Therefore, Opposer respectfully submits that Applicant's Motion to Dismiss should be denied.

II. ARGUMENT

A. STANDING DOES NOT REQUIRE OWNERSHIP OF A FEDERALLY REGISTERED TRADEMARK

Applicant has moved to dismiss the Opposition in its entirety with prejudice and allow the Applicant's Mark to mature to registration. In order to withstand a Motion to Dismiss for Failure to State a Claim Upon Which Relief Can Be Granted,

the Notice of Opposition need only allege such facts as would, if proven, establish that Opposer is entitled to the relief sought, that is, that (1) Opposer has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought. TBMP §503.02; See Young v. AGB Corp., 152 F.3d 1377, 47 U.S.P.Q.2d 1752, 1754 (Fed. Cir. 1998.) Opposer need not respond with proofs supporting its pleadings. TBMP §503.02. All of Opposer's well-plead allegations must be accepted as true, and the Notice of Opposition construed in the light most favorable to the Opposer. Id; See Ritchie v. Simpson, 170 F.3d 1092, 50 U.S.P.Q2d 1023, 1027 (Fed. Cir. 1999.) It is the duty of the Board to examine the complaint in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(f), to determine whether it contains any allegations, which, if proven, would entitle the Opposer to the relief sought. TBMP §503.02; See Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theaters, 56 U.S.P.Q.2D 1538 (T.T.A.B. 2000).

It is an error to state that an Opposer has no standing to oppose an application for registration because it cannot establish proprietary rights. Books on Tape v. Booktape Co., 836 F2d 519, 5 U.S.P.Q.2d 1301,1302 (Fed. Cir. 1987.) A competitor with equal rights to use the Mark has standing because it has an interest in the outcome beyond that of the general public. Id.; Wilson v. Delaunay, 245 F.2d 877, 114 U.S.P.Q. 339, 341 (C.C.P.A. 1957.) However, the Opposer must meet two judicially created requirements in order to demonstrate standing, (1) to have a "real interest" in the proceeding greater than that of the general public, and (2) have a "reasonable basis" for his belief of damage. Ritchie v. Simpson, 170 F.3d

1092, 50 U.S.P.Q.2d 1023,1025 (Fed. Cir., 1999.) To have standing, an Opposer must only be more than a mere intermeddler. See Id. at 1025; Lipton Indus., Inc. v. Ralston Purina Co., 670 F.2d 1024,1028, 213 U.S.P.Q. 185, 189 (C.C.P.A. 1982.)

B. DA VINCI DENTAL STUDIOS IS A STRONG MARK

Daniel Materdomini is the president and founder of da Vinci Dental Studios, Inc. He received his ceramic training in New York City in the early 60's under the tutelage of his father Master Ceramist Dominic Materdomini. He proceeded to perfect his talents and was soon recognized as one of the leading ceramists in the country. Daniel Materdomini founded da Vinci Dental Studios in the early 1970's, and in 1983, da Vinci Dental Studios introduced the first porcelain veneer. Daniel Materdomini, along with Dr. Mark Friedman and Dr. Robert Nixon, perfected the technique, which today is one of the most prescribed dental procedures available. In a joint venture with Johnson & Johnson®, material was developed and processes standardized to make the porcelain veneer available to the general public. da Vinci Dental Studios has co-produced and directed three videotapes on the veneering process, which are the accepted standards in dental labs nationwide. Daniel Materdomini has been published in numerous leading dental journals, is the only technician ever to receive the life time achievement award from the American Academy of Aesthetic Dentistry, and is a recognized member of the American Society for Dental Aesthetics. da Vinci Dental Studios has been featured on the hit television show "Extreme Makeover" and is part of the dental team on Fox network's "The Swan." Opposer da Vinci Dental Studios asserts that it has

developed significant goodwill in the DA VINCI Mark in interstate commerce, and that the Mark has become well-known, strong and famous as a distinctive indicator of the origin of Opposer's goods and services.

C. DA VINCI DENTAL STUDIOS HAS STANDING TO OPPOSE

As often occurs with small closely held companies, the DA VINCI trademark registration was originally issued in the principal's name and licensed to his company. As the company has grown, its intellectual property has required some legal bookkeeping, which has caused some transfers of ownership to occur. However, nothing about the transfers of ownership of the DA VINCI Mark changes the fact that Opposer has continuously used the Mark, as owner or licensee, on its goods and services since 1975, and will be harmed if the Application is granted.

Ownership of a federally registered trademark is not required in order to have standing to file an opposition. FBI v. Societe: "M. Bril & Co.", 172 U.S.P.Q. 310 (T.T.A.B. 1971.) All that is required is that the Opposer demonstrate that it is likely that it would somehow be damaged by the registration if it were granted. Id.; 15 U.S.C. §1063. Here, Opposer has alleged facts that show that it will be damaged by a likelihood of consumer confusion, as well as dilution of its trademark, if the Application is granted. Notice of Opposition ¶7-18. Opposer has further alleged facts that show it has a direct commercial interest in the Mark, and real interest in

the proceedings, because of the value of the goodwill it has built in this Mark since the early 1970's.[1] Notice of Opposition ¶1.

In arguendo, even if Opposer did not own the Mark, it would still have a real commercial interest in the proceeding, and thus would have standing to Oppose, because its use of the Mark is likely to be confused with Applicant's mark, and consumers could attribute defects in Applicant's goods to Opposer, or could be confused, deceived or erroneously assume that Applicant's goods are those of Opposer, or that Applicant is in some way connected with or sponsored by or affiliated with Opposer, all to Opposer's irreparable damage and injury. Here, it is clear that Opposer is entitled to priority use of the DA VINCI Mark, and thus may establish priority under §2(d) merely by proving prior use of the term in any manner "analogous to a trademark use." American Novawood Corp. v. U.S. Plywood-Champion Papers, Inc., 426 F.2d 823, 165 U.S.P.Q. 613 (C.C.P.A. 1970.) Therefore, even if Opposer did not own the DA VINCI Mark, which it does, the allegations of the Notice, interpreted liberally and viewed in the light most favorable to the Opposer as proscribed by law, would require a finding that Opponent has standing to Oppose. Applicant's Motion should therefore be denied.

[1] Opponent is in the process of filing its most recent assignment agreement regarding this Mark. Federal recordation of an assignment is permissive, not mandatory. Recordation protects only against a subsequent bona fide purchaser. Teter, Inc. v. Rheem Mfg. Co., 334 F.2d 784, 142 U.S.P.Q. 347 (7th Cir. 1964.)

D. DA VINCI DENTAL STUDIOS WILL BE HARMED IF APPLICATION IS GRANTED

Opposer's Notice of Opposition states as grounds for its Opposition of the Application that it is the "owner of all right, title, and interest in and to" the DA VINCI Mark, and that it has used the mark in interstate commerce from a date long prior to the filing of the Application. (Notice of Opposition ¶1, 3.) Opposer further alleges that the mark has become well-known and famous as a distinctive indicator of the origin of Opposer's goods and services, has acquired a highly favorable reputation among members of the purchasing public, and has become a valuable symbol of the Opposer's goodwill. (Notice of Opposition ¶4.) Opposer alleges a likelihood of confusion between Applicant's mark and Opposer's Mark, which are identical or so closely resemble each other as to be alike in appearance, sound and/or meaning, that the registration of Applicant's mark is likely to cause confusion, mistake, and deception as to the source or origin of Applicant's Goods, and will injure and damage Opposer and the goodwill and reputation symbolized by the Opposer's DA VINCI Mark. (Notice of Opposition ¶¶7-12.) Opposer further alleges that that the parties' goods are sold or intended for sale through the same trade channels to the same classes of prospective purchasers. (Notice of Opposition ¶10.) Opposer further properly pleads a count of Dilution under §43(d) of the Lanham Act, alleging that Opposer's DA VINCI Mark is arbitrary and inherently strong, as well as widely used and extensively advertised in the United States. (Notice of Opposition ¶¶13-18.) If the Application is granted, Opposer will be

deprived of the ability to protect its reputation, persona and goodwill. (Notice of Opposition ¶16.) Opposer has alleged that if the Applicant is granted it is likely that customers who encounter defects in the quality of Applicant's goods will attribute those defects to Opposer, and that this will dilute Opposer's reputation and goodwill. (Notice of Opposition ¶17.)

It should be clear from the foregoing that Opposer has a reasonable belief that it will suffer real harm if the Application is granted and that Opposer properly enumerated and alleged those harms in its Notice of Opposition.

E. APPLICANT MISSTATES THE LAW AND FACTS IN ITS MOTION TO DISMISS

Applicant argues that one basis for establishing standing is ownership of a mark which is similar to applicant's mark for similar goods. (Motion, p. 2-3.) This is true. However, Applicant then incongruously argues that this is the only basis for standing, by asserting that Opposer does not have standing and does not own the DA VINCI Registration. Applicant cites E.D. Bullard Co. v. Gentex Corp., 168 U.S.P.Q. 602 (T.T.A.B. 1970), for the proposition that an opposer must be the owner of a registered mark in order to have standing to oppose a registration. (Motion, p.3.)[2] To the contrary, Bullard stands for the proposition that an entity does not

[2] In Bullard, the Opposer was a company that made safety helmets. Bullard's President, E.W. Bullard, Jr., was a sponsor of a loosely-knit, non-profit, non-commercial, non-political and unaffiliated association called "The Turtle Club" that promoted more widespread use and acceptance of safety helmets.[2] Bullard at 603. There was never any written agreement regarding Mr. Bullard's relationship to the Turtle Club. Id. When E.D. Bullard Co. (the "Company") filed an opposition to the mark "TURTLE" for safety helmets, the Board found that it did not have standing to challenge the mark, because the Company could not show it would be damaged by the registration of the mark by the applicant. Id. In other words, the Company did not use the mark "TURTLE," and therefore could not be harmed by applicant's use, even though the Company's President was involved with the

have standing when it does not use the mark, does not own the registration, and is not even affiliated with the organization that does use the mark and own the registration.

The facts of the present case are thus distinguishable from Bullard. Here, the words "DA VINCI" are part of Opposer's corporate name, "da Vinci Dental Studios, Inc." While Opposer's founder, Daniel Materdomini, was the original registrant of the Mark, he has used it exclusively through Opposer since its first use. Opposer itself will be directly harmed by the use of the Mark by the Applicant. Thus, in no way does the fact pattern of the Bullard case apply to this Opposition.

Applicant also misstates the facts. In its Motion, Applicant asserts that Opposer "acknowledges that it does not own Registration No. 2,061,195." (Motion, p. 3-4.) This is untrue, as can be seen from the face of the Notice of Opposition. Opposer properly asserts that it has "owned and/or used the DA VINCI Mark since it was first adopted." (Notice of Opposition, ¶2.) This is a clear, correct, and properly plead statement that establishes standing to oppose the application. Nonetheless, Applicant claims Opposer's rights in the Mark are based on a third-party registration, and that it is clear that Opposer does not own the Mark. (Motion, p. 4.) This is not correct. Opposer has alleged ownership and/or use of the Mark DA VINCI. (Notice of Opposition, ¶2.)

Club. Id at 604. Further, the "Turtle Club" had registered the mark in its own name, and the Club was totally independent of the Company. Id.

Opposer has properly alleged its real interest in the Mark in its Notice of Opposition. For the purposes of evaluating a Motion to Dismiss for Failure to State a Claim, the Board must presume that the allegations of the Notice of Opposition are true, and find that Opposer has standing to oppose the Application. Ritchie, supra; TBMP §503.02.

Applicant incorrectly states that Opposer has "not alleged any other basis showing a 'real interest' in the proceeding or a 'reasonable belief' that it will be damaged." The Notice, on its face, alleges that Opponent has used, advertised and promoted the Mark in interstate commerce from long before the filing date of the Application. (Notice, ¶3.) Opposer has alleged that its Mark is well-known, famous and a distinctive indicator or the Opposer's good and services. (Notice, ¶4.) Opposer has also alleged that Applicant's goods are so closely related as to Opposer's goods and services that the public is likely to be confused, to be deceived, and to assume erroneously that Applicant's goods are those of Opposer or that Applicant is in some way connected with or sponsored by or affiliated with Opposer, all to Opposer's irreparable damage and injury. (Notice, ¶9.) Finally, Opposer has alleged that it will be harmed by dilution of its Mark if the Application is allowed to mature to registration, because use and registration of the mark ALEXANDRA DA VINCI by Applicant will deprive Opposer of the ability to protect its reputation, persona, and goodwill, and there is a likelihood of damage to Opposer's goodwill because prospective customers who encounter defects in the quality of Applicant's goods will attribute those defects to Opposer, and this will dilute Opposer's reputation and

goodwill. (Notice, ¶¶16, 17). These are clearly allegations of real interest and reasonable belief of damage. Thus, Applicant's arguments and Motion to Dismiss are baseless and the Motion should be denied.

III. CONCLUSION

Opposer has alleged such facts as would, if proven, establish that (1) Opposer has standing to maintain the proceeding, and (2) a valid ground exists for opposing the registration. Thus, Applicant's Motion to Dismiss for Failure to State a Claim upon Which Relief Can Be Granted must be denied.

LEAVE TO AMEND

If the Board finds upon determination of Applicant's Motion that the Notice of Opposition fails to state a claim for which relief can be granted, Opposer hereby moves in the alternative for Leave to Amend the Notice of Opposition. In respect of this motion in the alternative, Opposer would submit for the Board's consideration an Amended Notice of Opposition which alleges the additional facts contained herein that further support Opposer's standing and allegations of harm that it would incur if the Application is granted. Leave of the Board to Amend the Notice of Opposition should be freely given when justice so requires. TBMP §507.02.

WHEREFORE, Opposer respectfully requests that Applicant's Motion to Dismiss be denied. In the alternative, if Applicant's motion is not denied, then Opposer Moves for Leave to Amend its Notice of Opposition to set forth and allege

the facts herein, which will cure any alleged defect in its Notice of Opposition, rendering Applicant's Motion to Dismiss moot.

Respectfully submitted,

HOLLAND & KNIGHT LLP

Dated: 3/1/05

By _____
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Opposer's Opposition to Applicant's Motion to Dismiss was served upon the following attorneys of record for Applicant, by depositing a copy of same in the United States mail, postage prepaid, this 1 day of March, 2005.

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